

REMARKS/ARGUMENTS

Reconsideration of this application is requested. Claims 18-21, 24, 26-28 and 30-35 are in the case.

I. THE 35 U.S.C. §112/102 REJECTIONS

Claims 30-32 stand rejected under 35 U.S.C. §112, second paragraph, as allegedly indefinite, as directed to a use. Claims 30-32 stand rejected under 35 U.S.C. §101 as allegedly improper in not defining the process. In response, and without conceding to the merit of these rejections, claims 30-32 have been amended so as to be directed to a method of treatment. The claims are supported by the original subject matter contained in the original claims together with the disclosure in the paragraph bridging pages 5 and 6 of the application. No new matter is entered.

Withdrawal of the 35 U.S.C. §112 and 101 rejections is now believed to be in order. Such action is respectfully requested.

II. THE OBVIOUSNESS REJECTION

Claims 18-26, 29, 33 and 34 stand rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent 6,034,096 to Bertolini et al. That rejection is respectfully traversed.

In response to the obviousness rejection, and without conceding to the merit of that rejection, the claims have been amended to remove the possibility that L is a chain of 1 to 5 carbon atoms. The remaining claims have been amended so as to be consistent with this amendment.

Bertolini describes compounds of the Formula I as set forth at column 1, line 43 in which the wavy line extending between X and the terminal substituents on the left hand side of the molecule can be a chain of 1 to 5 carbon atoms optionally containing a double bond or a NR' group. The compounds as now claimed in the present application are structurally distinguished in that L is now absent, thereby removing the possibility of a carbon chain between X and the terminal groups on the left hand side of the molecule. Based on this amendment, it is believed that there is no *prima facie* case of structural obviousness over Bertolini.

Patentability of the presently claimed invention is further confirmed by comparative testing which has been performed. The comparative testing is described in the attached Exhibit 1 in which the compounds of Examples 1, 4, 5 and 15 of the present application were compared with the compound of Example 12 of Bertolini (D1, i.e., WO 97/43251, corresponds to the cited Bertolini U.S. Patent). The structures of the compounds are shown in Exhibit 2.

The comparative tests establish that the compounds of the present invention are less toxic, more stable and significantly more active than the closest prior art in several efficacy evaluations. These differences are surprising and could not have been predicted based on Bertolini. While it is not believed to be necessary, should the Office require the attached data to be presented in declaration form, it is requested that the undersigned be so advised and a declaration will be presented.

In light of the above, it is clear that one of ordinary skill would not have been motivated to arrive at the presently claimed invention based on Bertolini. Absent any

such motivation, a *prima facie* case of obviousness has not been generated in this case. Withdrawal of the obviousness rejection is respectfully requested.

III. **DOUBLE PATENTING**

Claims 18-26, 29, 33 and 34 stand rejected on obviousness-type double patenting grounds as allegedly unpatentable over claims 1-3 6 of U.S. Patent 6,034,096. In response, with the amendments in effect to the presently claimed invention, it is believed that there is no obviousness relationship between the claims of Bertolini et al and the presently claimed invention. Reconsideration and withdrawal of the outstanding obviousness-type double patenting rejection are accordingly respectfully requested.

IV. **ALLOWABLE SUBJECT MATTER**

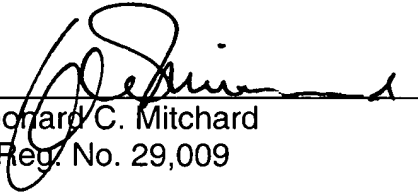
It is noted, with appreciation, that claims 27 and 28 are directed to allowable subject matter with the amendments effected in the present response, it is believed that all of the claims are in allowable condition. Early notice to that effect is respectfully requested.

Favorable action on this application is awaited.

PINORI et al
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Respectfully submitted,

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Attachments: Exhibits 1 and 2